

REMARKS/ARGUMENTS

Favorable consideration of this application in light of the following discussion is respectfully requested.

Claims 1-59 are pending in the application, with Claims 1, 19, 20, 38, 39 and 57 amended and Claims 58-59 added by the present amendment.

In the outstanding Office Action, Claims 1, 5, 6, 17, 20, 24, 25, 36, 38 , 39, 43, 44 and 55 were rejected under 35 U.S.C. § 102(e) as being anticipated by Yamada (U.S. Patent No. 6,239,837 B1); Claims 19 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada in view of Nakatani (U.S. Patent No. 5,063,459); Claims 2, 5, 6, 16, 21, 24, 25, 35, 40, 43, 44, and 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada in view of Wakui (U.S. Patent No. 5,742,339); Claims 7-9, 11-15, 26-28, 30-34, 45-47 and 49-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Yamada and Wakui applied to Claims 2, 21 and 40 above and further in view of Yoshiura et al. (U.S. Patent No. 5,854,693); Claims 3, 4, 22, 23, 41, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Yamada and Wakui as applied to Claims 2, 21, and 40 and further in view of well known prior art; Claims 18, 37, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada in view of well known prior art; and Claims 10, 29, and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over combination of Yamada, Wakui and Yoshiura as applied to Claims 8, 27 and 46 above, and further in view of Ikegaya et al. (U.S. Patent No. 5,379,124).

Applicants acknowledge with appreciation the personal interview between the Examiner and Applicants' representatives on March 22, 2006. During the interview, the Examiner indicated that amending the claims to clarify that the invention is not a camera would overcome the outstanding rejections.

Claims 1, 19, 20, 38, 39, and 57 are amended as discussed during the interview to more clearly describe and distinctly claim Applicants' invention. New Claims 58-59 are added to describe an embodiment of Applicants' claimed printing device. Support for these amendments is found in Applicants' originally filed specification. No new matter is added.

Claims 1, 19, 20, 38, 39, and 57 are amended to clarify that Applicants' invention is directed to a multifunction copying device. In conventional copying devices, when image data is transferred from an external device to an internal device, usually the internal storage device does not have a capacity large enough to store mass image data. Moreover, conventional internal storage devices are implemented with a type of memory requiring a plurality of inefficient write accesses to occur at the same time in the event of storage. With Applicants' claimed invention it is not necessary for a plurality of simultaneous write accesses ascribable to a memory full condition. Applicants' invention promotes efficient use of the storage media attached thereto.¹

As noted in Applicants' previous correspondence, and as acknowledged by the Examiner during the interview, Yamada and Wakui are directed to digital *cameras* and still video *cameras*, respectively. Yamada and Wakui are not directed to an image printing device as disclosed in Applicants' specification and recited in Applicants' amended independent claims. Thus, Applicants submit that, with Applicants' clarifying amendment, Yamada and Wakui are nonanalogous to Applicants' claimed invention. Thus, Applicants request all rejections based on Yamada and Wakui be withdrawn.

Briefly recapitulating, amended Claim 1 is directed to an image printing device including an image data storing device. The image data storing device includes at least two storing means different in storing format from each other, each for storing image data input via inputting means, the at least two storing means including an external storage and at least

¹ Specification pages 1-3.

one of a video memory and a hard drive. The image data storing device also includes a transfer control means for controlling a transfer of the image data between the plurality of storing means; and checking means included in the transfer control means for determining whether or not storing means included in a destination, to which the image data should be transferred, has a capacity great enough to store the image data. The image printing device is further configured to output to a sheet an image corresponding to the image data directly.

Independent Claims 19, 20, 38, 39, and 57 are directed to alternative embodiments of Applicants' image printing invention. With at least two storing formats, improved reliability and performance is achieved. Thus, the claimed inventions allow for more efficient device memory management.²

Yamada discloses a multi-memory management system *configured for use in a camera*.³ Yamada does not disclose or suggest an image printing device configured to print an image on a sheet.

Also, in Yamada, there are two storing means, where one is a non-volatile semiconductor memory and the other is a sub-memory, both of which are semiconductor memories. Therefore, Yamada does not disclose or suggest at least two storing means different in storing format from each other, where the at least two storing means including an external storage and at least one of a video memory and a hard drive as recited in Applicants' amended independent claims. Because Yamada does not disclose or suggest all the elements of independent Claims 1, 19, 20, 38, 39, and 57, Applicants submit the inventions defined by Claims 1, 19, 20, 38, 39, and 57, and all claims depending therefrom, are not anticipated by the asserted prior art for at least the reasons stated above.⁴

² Specification, page 2, lines 7-16.

³ Yamada, column 6, line 32 – column 7, line 10

⁴ MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP § 2131 notes that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02. “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Because Yamada does not disclose or suggest all the features recited in Claims 1, 19, 20, 38, 39, and 57, Yamada does not anticipate the invention recited in Claims 1, 19, 20, 38, 39, and 57, and all claims depending therefrom.

Applicants have also considered the cited Wakui, Nakatani, and Ikegaya references and submit these references do not cure the deficiencies of Yamada. Wakui, like Yamada, discloses a camera memory. Wakui does not disclose or suggest an image printing device configured to print an image on a sheet. Wakui, Nakatani, and Ikegaya each fail to disclose or suggest at least two storing means different in storing format from each other, where the at least two storing means including an external storage and at least one of a video memory and a hard drive as recited in Applicants’ independent claims. Like Yamada, each of these references disclose semiconductor memories.

Yoshiura discloses a copier with a semiconductor memory. However, like the previously described references, Yoshiura does not disclose or suggest at least two storing

means different in storing format from each other, where the at least two storing means including an external storage and at least one of a video memory and a hard drive as recited in Applicants' amended independent claims.

Furthermore, Applicants submit there is no teaching, suggestion, or motivation, either explicitly or implicitly, in either reference to combine the camera memories of Yamada or Wakui with the copier memory of Yoshiura to arrive at Applicants' inventions recited in amended Claims 1, 19, 20, 38, 39, and 57. Similarly, Applicants submit that the rejection of Applicants' claimed inventions in view of the combination of the camera memory of Yamada with the facsimile memory of Nakatani or Ikegaya is also based on improper hindsight reasoning.

Applicants also submit that camera art of Yamada is not analogous to the facsimile art of Nakatani and Ikegaya or the copier art of Yoshiura and, thus, for another reason, rejections based on combinations of these references are based on improper hindsight reasoning.

MPEP §706.02(j) notes that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Without addressing the first two prongs of the test of obviousness, Applicants submit that the Official Action does not present a *prima facie* case of obviousness because each of the applied references fail to disclose all the features of Applicants' claimed invention.

Accordingly, in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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